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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/396,128    09/14/99    THOMPSON

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EXAMINER

PM82/1204

THOMAS THOMPSON  
92-543 KOKOLE PLACE  
MAKAKICO HI 96707

TRAN, H

ART UNIT

PAPER NUMBER

3636

DATE MAILED:

12/04/00

AIR MAIL

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/396,128

Applicant(s)  
THOMPSON

Examiner  
Hanh V. Tran

Group Art Unit  
3636



☒ Responsive to communication(s) filed on Sep 20, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) 9-14 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 and 15-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. This is the First Office Action on the Merits from the examiner in charge of this application in response to applicant's facsimile paper dated 9/20/2000.

#### ***Election/Restriction***

2. Applicant's election without traverse of invention I, claims 1-8, and 15-19 in Paper No. 4 is acknowledged.

#### ***Drawings***

3. The drawings are objected to because the specification discloses in the Brief Description of the Drawings of figure 6A, however, figure 6A is not included in the drawing sheets. Correction is required.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation in claim 7 of "attachment to roof sheathing" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-8, and 15-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 15, line 1, "Apparatus" should be "An

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apparatus". Claim 1, line 7, the term "said approximately right angled bends" is indefinite for failing to clearly define the angled bends of the sheathing tabs or the rafter tabs. Claim 2, the limitation "according to standard construction dimensions" is indefinite, since standard may change over time. Claim 3, line 1, "predetermined" should be "a predetermined". Claim 4, line 1, (a) "said wall tab" lacks antecedent basis, (b) "predetermined" should be "a predetermined", line 2, "said outside sheathing" lacks antecedent basis. Claim 5, line 1, "predetermined" should be "a predetermined", line 2, "vertical edge" should be either "vertical edges" or "a vertical edge". Claim 6, line 1, "predetermined" should be "a predetermined". Claim 7, line 1, "said sheathing tabs" lacks antecedent basis. Claim 8, line 1, "wall tab" lacks antecedent basis. Claim 15, line 4, "said flat plates having a wall tab" should be "said flat plates each having a wall tab". Claim 17, line 1, "said head" lacks antecedent basis.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claims 1 and 15 clearly indicates that a subcombination is being claimed, e.g., "an apparatus for securing structural members" of a building. This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "an apparatus," the "structural members" of a building being only functionally recited. This presents no problem as long as the body of the claim also refers to the "structural members" functionally, such as, "for attachment to said rafters".

The problem arises when the "structural members" is positively recited within the body of the claim, such as in claims 8 and 19. There is an inconsistency among the claims; the preamble

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indicates subcombination, while in at least one instance in the body of the claims there is a positive recital of structure indicating that the combination of an apparatus and structural members are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the apparatus or the apparatus in combination with the structural members.

Applicant is required to clarify what the claims are intended to be drawn to. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination of the apparatus and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination. Should applicant's intent is to claim the subcombination, then throughout the claims, each instant of "means of attachment" should be "means for attachment".

Since the claims are replete with unclear and indefinite terms, all claims will be examined as best understood.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-6, and 8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,370,577 to JONETT ET AL.

JONETT ET AL discloses an apparatus for securing structural members of a building, FIGs 2-3, comprising all the elements recited in the above listed claims and including a unitary body 22 having a rectangular face with ventilation holes 24, sheathing tabs 26, rafter tabs 32', plate tabs 46', and wall tabs 72, wherein each tab has a plurality of nail holes.

9. Claims 1-2, 4-8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,236,273 to GILB.

GILB discloses an apparatus for securing structural members of a building, FIG 9, comprising all the elements recited in the above listed claims and including a unitary body 27 having a rectangular face, sheathing tabs 34-36, rafter tabs 32, and plate tabs 33, wherein each tab has a plurality of nail holes.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 15-19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over JONETT ET AL.

JONETT ET AL discloses an apparatus for securing structural members of a building, FIGs 2-3, comprising all the elements recited in the above listed claims and including a unitary body 22 having a rectangular face with ventilation holes 24, sheathing tabs 26, rafter tabs 32', plate tabs 46', and wall tabs 72, wherein each tab has a plurality of nail holes. The only difference being that JONETT ET AL does not disclose the apparatus being formed of two flat plates, with one of said plates having horizontal tracks with openings on one end, and the other plate having runners with faces and arms.

It would have been obvious and well within the level of one skill in the art to modify the apparatus of JONETT ET AL by having the apparatus being formed of two flat plates, with one of said plates having horizontal tracks with openings on one end, and the other plate having runners with faces and arms for the purpose of making the apparatus adjustable to different sizes.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the apparatus of JONETT ET AL being formed of two flat plates, with one of said plates having horizontal tracks with openings on one end, and the other plate having runners with faces and arms, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954) .

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*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. LUCKEY '649, LUCKEY '973, HUMPHREY, PEARSON, HESS, and GIBSON all show structures similar to various elements of applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (703) 308-6302.

HVT  
November 29, 2000

  
**Hanh V. Tran**  
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